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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,464	11/12/2003	David G. Kuehr-McLaren	RSW920010117US1	6754

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EXAMINER

DUNHAM, JASON B

ART UNIT PAPER NUMBER

3625

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/706,464	Applicant(s) KUEHR-MCLAREN ET AL.	
	Examiner Jason B. Dunham	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/12/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Epling (U.S. Patent Application Publication No. 2005/0091101).

Referring to claim 1. Epling discloses a method for conducting electronic commerce transactions among participants in an E-marketplace, comprising the steps of:

- Obtaining privacy-use information for each participant (paragraph 27 & figure 1);
- Comparing the privacy use information for each participant to determine matches (figure 2);
- Only allowing transactions to occur between participants who have matching privacy use information (paragraph 11 and figure 3). The examiner notes that Epling discusses stopping any transactions before they occur if the privacy use information does not match.

Referring to claim 2. Epling further discusses a method wherein said obtaining step comprises at least the step of requiring each participant in the E-marketplace to present to the E-marketplace their P3P policy (paragraph 9 & figure 2).

Referring to claim 3. Epling further discloses a method wherein said obtaining step comprises at least the steps of:

- Presenting each participant with questions that elicit their privacy-use information (paragraph 27); and
- Storing the elicited privacy-use information for use in said comparing step (paragraph 29).

Referring to claim 4. Epling further discloses a method wherein said privacy-use information includes at least one of: use information pertaining to elicited e-mail addresses; use information pertaining to financial; use of personal information; use of business information, and the delivery of advertising to the participant (paragraph 18).

Referring to claims 5-8. Claims 5-8 are rejected under the same rationale as set forth above.

Referring to claims 9-12. Claims 9-12 are rejected under the same rationale as set forth above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 rejected under 35 U.S.C. 103(a) as being unpatentable over Barzilai (U.S. Patent Application Publication No. 2002/0029201), in view of McCollom (U.S. Patent No. 6,343,274).

Referring to claim 1. Barzilai discloses a method for conducting electronic commerce transactions among participants in an E-marketplace, comprising the steps of:

- Obtaining privacy-use information for each participant (Barzilai: abstract)
- Comparing the privacy use information for each participant to determine matches (Barzilai: abstract)
- Barzilai teaches all of the above, but does not expressly disclose a method wherein transactions are not allowed if participants do not have matching privacy-use information. McCollom discloses a method wherein transactions are allowed only if participants' privacy use information matches (McCollom: column 2, lines 30-55). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Barzilai to bar transactions between participants whose privacy-use information profiles do not match, as taught by McCollom, to allow consumers to protect their personal data (McCollom: column 2, lines 7-29)

Referring to claim 2. Barzilai further discusses a method wherein said obtaining step comprises at least the step of requiring each participant in the E-marketplace to present to the E-marketplace their P3P policy (Barzilai: paragraph 12).

Referring to claim 3. Barzilai further discloses a method wherein said obtaining step comprises at least the steps of:

- Presenting each participant with questions that elicit their privacy-use information (Barzilai: paragraph 12); and
- Storing the elicited privacy-use information for use in said comparing step (Barzilai: paragraph 42).

Referring to claim 4. Barzilai further discloses a method wherein said privacy-use information includes at least one of: use information pertaining to elicited e-mail addresses; use information pertaining to financial; use of personal information; use of business information, and the delivery of advertising to the participant (Barzilai: paragraphs 13 & 21).

Referring to claims 5-8. Claims 5-8 are rejected under the same rationale as set forth above.

Referring to claims 9-12. Claims 9-12 are rejected under the same rationale as set forth above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- "A new privacy tool is at your disposal now - warts and all," Wall Street Journal, 10 September 2001, Proquestion # 80041350, 3 pages.: teaches the use of P3P to maintain user privacy in transactions and the blocking of cookies.

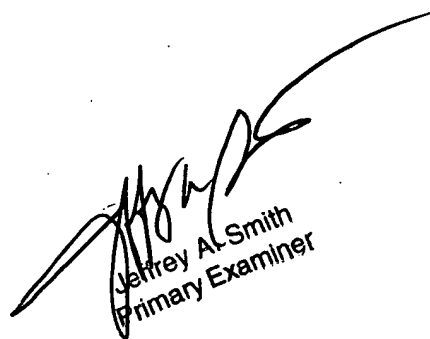
Art Unit: 3625

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason B. Dunham whose telephone number is 571-272-8109. The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JBD



Jeffrey A. Smith
Primary Examiner